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Shubha Ghosh
ghosh7@wisc.edu

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RAZING THE FUNHOUSE?

*Shubha Ghosh**

Whether as a scholar or just an ordinary thoughtful person, one cannot completely ignore history. At the same time, the past is annoying, used to promote a whole host of agendas in the guise of tradition, legitimacy, respect. Michael Risch's engaging and just plain fun article looks at America's First Patents and asks about the relevance of history to law.¹

The engagement with history might seem particularly irrelevant for the field of intellectual property with its concern for the new, new thing and for progress. Why should the past matter? As Professor Risch shows, while intellectual property policy is concerned with the future, understanding its moorings in the past provides perspective on how to shape intellectual property law.² Progress is as much about cumulative creation as it is about erasure. Of course, as with much legal argumentation, one needs to sift and winnow through the record and separate rhetoric from insight. I think that is Professor Risch's primary goal in his examination of the first patents. Judges appeal to history in deciding contemporary patent cases, but it seems that they use the purported historical record in a purely instrumental way. Like any good scholar, Professor Risch shows us that the reality is more complicated than what we take to be historical fact.

Although he may have overstated the claim, George Santayana struck a kernel of truth in observing that forgetting history results in reliving it over and over.³ Avoiding that eternal recurrence is to recognize the study of history as a sort of travel, an engagement in comparative thinking. To study history is to travel to a different mindset and understand the local customs and ways of living. Those experiences, if sufficiently deep and genuine, can be beneficial. History is a series of experiments, some successful, most failed. The problem is that history by itself does not give us a metric to gauge what is success and what is failure. That's why originalism as a mode of interpretation and as a basis for legal policy cannot really take us anywhere. It is not much of a trip if your roadmap and compass are centuries old.

The mismatch between historical method and normative signposts is ultimately what I found unsatisfying about Professor Risch's article. By analyzing America's first patents, the article engages in originalism of sorts. But the point is to show how complex the historical record is.

*. Vilas Research Fellow & Professor of Law, University of Wisconsin Law School.

1. Michael Risch, *America's First Patents*, 64 FLA. L. REV. 1279, 1281 (2012).

2. *See id.*

3. *See* 1 GEORGE SANTAYANA, *Reason in Common Sense*, in *THE LIFE OF REASON OR THE PHASES OF HUMAN PROGRESS* 284 (2d ed. 1922) ("Those who cannot remember the past are condemned to repeat it.").

Justice Stevens is that target here, especially his assertion that, as a historical matter, patentable subject matter with respect to processes was quite narrow.⁴ Professor Risch looks not just at the case law, but also at the practices of patenting showing something more ambiguous than what Justice Stevens asserts.⁵ For example, business methods were patented in the Nineteenth Century.⁶ One can question whether Professor Risch might have too generous a definition of business methods, but nonetheless his basic point strikes me as correct. There was no clear prohibition against business method patents, and from the perspective of practice, what could be the subject of patents is broader than Justice Stevens lets on.⁷

The problem is that facts do not by themselves tell us what to do. Caution should inform the engagement with fact. By looking at the period up to 1836, when the patent system in the United States was structured as a registration system with no administrative review, Professor Risch examines a period when anything goes.⁸ Of course, he does extend the analysis to three years after the regime change towards an administrative system.⁹ The point, however, remains is that when there is a fundamental change from an open registration system to a regulated administrative one for determining who gets patents, there is a problem of commensurability.

In part, the United States rejected the registration system for patents because of the unpredictability it introduced.¹⁰ Identifying ownership was confounding; questionable inventions were protected by federal law. These concerns might sound familiar because they are raised with respect to the copyright system today. I was a bit lost as to what the historical record under the registration system would imply for patent administration. Both Justice Stevens and Professor Risch might be wrong about patentable subject matter because the change in regime tells us nothing about what patentable subject matter should be.

Business method patents seem to be Professor Risch's primary concern in the contemporary debate over the scope of patentable processes.¹¹ But a business method is only one type of process at issue. Perhaps more salient is the patentability of medical diagnostic and treatment methods. The Supreme Court addressed medical methods in its 2012 *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*

4. See Risch, *supra* note 1, at 1326–37 (citing *Parker v. Flook*, 437 U.S. 584, 596 (1978)).

5. *Id.* at 1320–25.

6. *Id.* at 1320–21.

7. *Id.* at 1327.

8. *Id.* at 1281–82.

9. *Id.* at 1282.

10. See *id.* at 1282 & n.12.

11. See Risch, *supra* note 1, at 1328, 1334.

decision.¹² Professor Risch identifies many early patents covering medicines, but only a few are what I would call medical method patents.¹³ What should we make of that? One view might be that medical methods are not historically recognized. Of course, that ignores technological developments in the past fifty years that would make the patentability of medical methods a relevant question. Professor Risch would say that history weighs in favor of broad subject matter to accommodate changes in technology. I think that is basically right, but I do not think history tells us anything here about the range of ethical and policy concerns raised by medical methods. For example, how do medical method patents affect the treatment of patients? Do patents on medical diagnostics actually lead to progress in the field? History aids in answering these questions by offering context. But by itself history is largely silent on how to move forward.

We need to step outside of the funhouse of history and ask what we find so entertaining. Professor Risch demonstrates how appeal to history can be misdirected. He takes us out of the funhouse by showing us that it has far more rooms than we imagined. But one still has to wonder what the rest of the neighborhood looks like.

12. No. 10-1150 at 3 (Mar. 20, 2012).

13. See Risch, *supra* note 1, at 1312, 1316, 1317.